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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LY, CHEYNE D

ART UNIT PAPER NUMBER

2168

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/646,941	Applicant(s) THOMPSON ET AL.	
	Examiner Cheyne D. Ly	Art Unit 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-84 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-84 is/are rejected.
- 7) ☒ Claim(s) 1,51 and 68 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/9/14</u> | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-84 are examined on the merits.

OBJECTIONS

2. The abstract of the disclosure is objected to because of the term ("Items"). Applicant is required to remove the parentheses and quotation marks. Further, Applicant is required to submit a new abstract on a separate sheet of paper. See MPEP § 608.01(b).
3. This application filed under 37 CFR 1.78 lacks the necessary reference to the prior application. Paragraph [0001] of the instant application does not have the current status of the commonly assigned applications. The current status of the parent nonprovisional application(s) should be included.
4. The disclosure is objected to because of the phrase "[Remainder of Page Intentionally Left Blank]" on pages 11 and 179. Appropriate correction is required.
5. Claim 1 is objected to because of the term ("Items"). Applicant is required to remove the parentheses and quotation marks. The same issue is present in claims 51 and 68.

Double Patenting

STATUTORY TYPE

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

7. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.
8. Claims 1 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 11 of copending Application No. 10/646,645. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

NONSTATUTORY TYPE

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

10. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.
11. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
12. Claims 51 and 68 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 21 and 1, respectively, of copending Application No. 10/646,645. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention recited by claims 1 and 21 of the copending application is an obvious variant of the invention claimed by the instant application. It is noted that claims 51 and 68 do not recite the limitation of “managing said relationships.” However, it would have been readily obvious to one of ordinary skill in the art at the time of the invention that the system recite in claim 51 of the instant application manages the recited relationships. Further, “A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double

patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). “ ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

13. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

CLAIM REJECTIONS - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

15. Claims 1-18, 33-59, 62-76, and 79-84 are rejected under 35 U.S.C. 102(b) as being anticipated by D’Andrea & Janus (1996) (D’Andrea hereafter).
16. It is noted that D’Andrea discloses “four fundamental object extensions...Taken together with extension #1, class composition, the data model is a Directed Acyclic Graph (DAG)” (page 71, last paragraph). The disclosure anticipates the pluralities of relationships of the claimed invention as discussed below. Further, the citation portion of D’Andrea discloses 4 types of objects (Items) as defined by the instant specification (page 32). The objects (Items) anticipate the limitations of first and second Items required by the claims as discussed below.
17. In regard to claim 1, D’Andrea discloses a computer-readable medium with computer-readable instructions for a hardware/software interface system for a computer system

(pages 73-74, Balanced Client-Server Architecture section, and pages 75 and 76, 3rd paragraph), wherein said hardware/software interface system manipulates a plurality of discrete units of information (page 72, 2nd paragraph), said items interconnected by a plurality of Relationships managed by said hardware/software interface system (page 71, last paragraph).

18. In regard to claim 2, a first Item has a relationship from itself to a second Item (page 71, last paragraph).
19. In regard to claim 3, the Relationship from said first Item to said second Item logically denotes in said hardware/software interface system that the said second Item is public and accessible to said first Item (page 72, 2nd paragraph, and page 73, lines 3-4). It is noted that the disclosure of an object-oriented data model comprising inheritance and encapsulation wherein shared attributes may be stored once in the class instance and shared amongst all instances of the class reasonably support the limitation of “second Item is public and accessible to said first Item.”
20. In regard to claim 4, the first item is an Item Folder (page 71, last paragraph and page 71, last paragraph). It is noted the disclosure of “class” by D’Andrea has been interpreted as an Item Folder as described by the instant specification (page 37).
21. In regard to claim 5, the second Item is an Item Folder (page 71, last paragraph and page 71, last paragraph). It is noted that D’Andrea discloses “The datatype of a column can be a class” (page 71, last paragraph) and a plurality of datatypes (page 71, last paragraph). Therefore, the disclosure by D’Andrea of a plurality of different classes has been interpreted as the second Item is an Item Folder (class).

22. In regard to claim 6, the second Item is a Category (page 71, last paragraph). It is noted the disclosure of “collections” by D’Andrea has been interpreted as a Category as described by the instant specification (page 37).
23. In regard to claim 7, the second Item is an Item that is not an Item Folder or a Category (page 71, last paragraph). It is note the disclosure of “attribute” and “Methods” have interpreted as an Item that is not an Item Folder or a Category.
24. The citation above anticipates claims 8-18 and 33-46.
25. In regard to claim 47, each Item from among said Items has a relationship to at least one other Item (page 71, last paragraph).
26. In regard to claim 48, a subset of Items comprise Item Folders (page 72, 2nd paragraph, and page lines 6-7).
27. The citation above anticipates claims 49 and 50.
28. Further, the citation above anticipates the system and method recited by claims 51-59, 62-76, and 79-84.

Claim Rejections - 35 USC § 103

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
30. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

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various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

31. Claims 19-32, 60, 61, 77, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Andrea & Janus (1996) (D'Andrea hereafter) as applied to claims 1-18, 33-59, 62-76, and 79-84 above, and further in view of Barker (2000).
32. D'Andrea describes the limitations to claims 1-18, 33-59, 62-76, and 79-84 as discussed above. However, D'Andrea does not describe the limitation of "Item does not have a Relationship to said first Item" and "wherein a lack of a Relationship from said second Item to said Item logically denotes in said hardware/software interface system that said first Item is private an inaccessible to said second Item."
33. D'Andrea describes an improvement for the next generation DBMS that is fast and cost-effective by taking advantage of the flexibility, productivity, and performance benefits of OO modeling (Abstract etc.). Barker describes software objects (page 1) and "what does it take to be a successful object modeler" (page 54). An artisan of ordinary skill in the art at the time of the instant invention would have been motivated by the improvement described by D'Andrea to improve the method of D'Andrea with the OO modeling technique described by Barker.

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34. In regard to claim 19, Barker describes second Item does not have a Relationship to said first Item (page 94, Private visibility section).
35. In regard to claim 20, Barker describes a lack of a Relationship from said second Item to said first Item logically denotes in said hardware/software interface system that said first Item is private and inaccessible to said second Item (page 94, Private visibility section).
36. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the computer-readable medium, system and method as described by D'Andrea and Barker.
37. Further, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the computer-readable medium, system and method as described by D'Andrea and Barker as recited in claims 21-32, 60, 61, 77, and 78.

CONCLUSION

38. Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center

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supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

39. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199. The USPTO's official fax number is 571-272-8300.

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716.

The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

41. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached on (571) 272-4146.

C. Dune Ly *CDL*
Patent Examiner
2/17/06


JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100